

II. REMARKS

A. Status

Claims 1-25 are currently pending in this Application.

In the Office Action, claim 17 is objected to because of a typographical error. Office Action at 2. Claims 1-14 were rejected under 35 U.S.C. §112, second paragraph, as indefinite. *Id.* Claims 1-3 and 9-20 were rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 6,128,402 (“Jones”). *Id.* at 3-4. Claims 4 and 6-8 were rejected under 35 U.S.C. 103(a) as being obvious over Jones in light of U.S. Patent No. 4,554,444 (“Hirose”). *Id.* at 4-5. Finally, claim 5 was rejected under 35 U.S.C. 103(a) as being obvious over Jones in light of Hirose and in further light of U.S. Patent No. 4,340,150 (“Guibord”). *Id.* at 5.

In the current Amendment, claim 17 is amended to overcome the objection, replacing the word “sad” with the word “said.” Amendment at 6. Claims 1-20 are amended to overcome the indefiniteness rejection. *Id.* at 2-8. Old dependent claim 11 is amended to create new independent claim 11, which includes the limitations of original claims 9-11, thus traversing the §102 rejection of claims 1-3 and 9-20. *Id.* at 2. Independent claim 15 is also amended to overcome the §102 rejection of claims 15-19. *Id.* at 5-6. Independent claim 20 is also amended to overcome its §102 rejection. *Id.* at 7-8. Finally, new claims 21-25 are added, but no new matter has been incorporated. *Id.* at 8-9. Support for claims 21-25 can be found in the specification. *See, e.g.*, Application at 5-17. While new claims 21-25 have not been previously examined, Applicant believes that they avoid all of the above-mention rejections for the reasons set forth below.

B. Claims Are Not Anticipated By Jones

In the Office Action, claims 1-3, 9-20 are rejected under 35 USC §102(b) as being anticipated by Jones. Office Action at 3. Applicant believes that the claims, as amended, traverse the §102 rejections for the following reasons.

1. Independent Claims 1, 11, 15, 20, and 21 Recite Distinguishable Features

The banknote handling systems referred to in independent claims 1, 15, 20, and 21 are all characterized by *at least one* of the following features:

- (a) banknote discrimination modules that carry out banknote discrimination of each banknote in a transaction process other than a money-in process (such as a money-out process and a feeding process), if it is accompanied with conveyance of banknotes, as well as in the money-in process;
- (b) a banknote storage box stores genuine banknotes while a collection box collects counterfeit banknotes; and
- (c) a management module manages information on the transaction process with respect to each banknote.

These features, at least, are distinguishable over the cited prior art, Jones. *See* Amendment at 2-9.

2. Jones Does Not Anticipate Claim 1

Features (a) and (c) are recited in claim 1, which includes “multiple banknote discrimination modules” for “a transaction process that is accompanied with a conveyance of

banknotes, “ feature (a), and, “a management collection module [that] manages the transaction process with respect to each banknote,” feature (c). Amendment at 2.

Jones fails to disclose features (a) and (c). Specifically, with regard to feature (a), Jones describes the case of cash deposit and provides no disclosure of allowing banknote discrimination modules to carry out banknote discrimination of each banknote in a transaction process *other than a money-in process* (such as a money-out process and a feeding process), if it is accompanied with conveyance of banknotes. *See, e.g.*, Jones at 8:9-53. Jones does not assume the handling of counterfeit banknotes in a money-out process. In the unlikely event that the money-out transaction included some counterfeit banknotes, they would be received by the customer and not detected by the invention in Jones. *Id.* at 9:33-51.

With regard to feature (c), the Office Action refers to step 10b in Fig. 1d of Jones. Office Action at 3. Fig. 1d of Jones shows steps of respective transactions, and Jones does not mention “management for each banknote”. Instead, Jones discloses the management of information for *each transaction*, not for each individual banknote. *Id.* In contrast to Jones, the banknote handling system recited in claim 1, “manages transaction information for each banknote,” such that some banknotes will be stored in the banknote storage box and some banknotes will be collected in the collection box during one transaction. Application at 3-4. This configuration makes it possible to manage the source of *each banknote* wherever it goes.

Accordingly, claim 1 is not anticipated by Jones.

3. Jones Does Not Anticipate Claim 11

Dependent claim 11 is amended to create independent claim 11, which incorporates all of the limitations recited in independent claim 1 as well as dependent claims 9 and 10. *See*

Amendment at 2. Jones does not anticipate amended independent claim 11 as Jones does not teach feature (a), a transaction process other than a money-in process (such as a money-out process or a feeding process).

New independent claim 11 is directed to a banknote handling system where transactor information includes an account number and an employee number. *Id.* To be more specific, the claimed system includes the number of an employee who is in charge of a subject ATM as well as customer information in the transactor information, and this allows the employee who feeds the ATM with banknotes to be managed as the source data. Once a counterfeit banknote is discovered, it is possible, by referring to the source data of each banknote, to determine whether the counterfeit banknote is deposited in a money-in process or it is placed in the ATM from the beginning. Jones only discloses a money-in process and gives no consideration to managing a feed process by a bank employee. Hence, Jones does not anticipate new independent claim 11.

4. Jones Does Not Anticipate Claim 15

The Office Action also rejected independent claim 15 as being anticipated by Jones. Office Action at 3.

The banknote handling system recited in independent claim 15 includes a management module that manages source data of each banknote stored in the banknote storage box. Amendment at 5-6. This is the reason why a control unit controls the management module to update the source data of the banknote managed corresponding to the banknote storage box when a banknote is stored and fed from the banknote storage box. Specifically, when a banknote is fed from the banknote storage box, the source data of the banknote fed from the banknote storage box is deleted, and when a banknote is stored in the banknote storage box, the source data of the

banknote stored in the banknote storage box is added. Jones, on the other hand, does not manage source data for each banknote and does not disclose a transaction process other than a money-in process, such as a money-out process or feeding process. As such, Jones does not anticipate claim 15.

5. Jones Does Not Anticipate Claim 20

Independent claim 20 was also rejected as being anticipated by Jones. Office Action at 3.

Even though claim 20 is a method claim, it includes steps that employ features (a) and (c) mentioned above. For example, the claim recites the step of “managing mapping of the transactor information with respect to each banknote,” which corresponds to feature (c). Amendment at 8. Similarly, the step of, “feeding out the stored banknote,” corresponds to feature (a). Amendment at 8.

Thus, the same arguments set forth above for independent claims 1 and 15 are also true of claim 20. Jones does not include each and every limitation of claim 20 and therefore Jones cannot anticipate claim 20.

6. Jones Does Not Anticipate Claim 21

New claims 21-25 have not yet been examined. However, independent claim 21 includes features (a) and (c) mentioned above. Feature (a) recites: “a transaction process that is accompanied with a conveyance of banknotes.” Amendment at 8. Similarly, claim 21 also recites feature (c): “a management module for managing information...with respect to each banknote.” *Id.* Jones, on the other hand, does not include features (a) and (c), as previously discussed. Thus, the same arguments set forth above for independent claims 1 and 15 are also true of new claim 21. Because Jones does not include each and every limitation of claim 21, Jones cannot anticipate it.

7. Jones Does Not Anticipate Dependent Claims

Claims 1-3 and 9-20 were rejected as being anticipated by Jones. Office Action at 3. Those claims include dependent claims 2-3 and 12-14 that are still pending in the present Application.

Dependent claims are not anticipated if the independent claim from which it depends is novel. *Hartness Int'l Inc. v. Simplimatic Eng'g Co.*, 819 F.2d 1100 at 1108 (Fed. Cir. 1987). Accordingly, claims 2-3 are not anticipated because claim 1, as amended, is novel and dependent claims 12-14 are not anticipated because new independent claim 11 is novel. Similarly, claims 16-19 are not anticipated because claim 15, as amended, is novel. Finally, new claims 22-25 are not anticipated because new independent claim 21, as originally drafted, is novel.

C. Claims 4-6 And 8 Are Not Obvious

1. Claims 4 And 6-8 Are Not Obvious Over Jones In View Of Hirose

Claims 4, and 6-8 were rejected under 35 USC §103(a) as being unpatentable over Jones in view of Hirose (USP 4,554,444). Office Action at 4-5.

Hirose is cited for specific features not relevant to the distinction of independent claim 1 over Jones. Hence, the proposed combination would not meet all requirements of claim 1 or any of its dependent claims and the dependent claims patentably distinguish over Jones and Hirose. However, the dependent claims further distinguish over the art.

Regarding claim 4, the Office Action alleges that, "it would have been obvious...to modify the banknote handling system of Jones with a money-out process, as taught by Hirose, for the purpose of the deposited banknotes being used as banknotes for withdrawal." *Id.* at 4.

However, unlike Hirose, claim 4 does not recite the use of deposited banknotes for subsequent withdrawal. Amendment at 3. Instead, the banknote storage boxes are for storing

banknotes classified by banknote type. Application at 8:1-8. Accordingly, claim 4 is not obvious over Jones in view of Hirose.

Regarding claims 6-8, the Office Action alleges that, “it would have been obvious...to modify Jones’s banknote handling system with a banknote feed process that supplies banknotes to the banknote storage box from a place other than the money in-out slot, as taught by Hirose, for the purpose of separately depositing notes of several denominations.” Office Action at 4-5. However, unlike Hirose, claims 6-8 recite the use of a detachable cassette for a banknote feed operation from the bank and for a banknote collection process. Amendment at 4; *see also* Application at 8:10-18. That is to say, providing banknotes to/from the cassette is not for the purpose of “depositing notes of several denominations.” Hence, the combination of Jones and Hirose would not include the recited detachable cassette. Accordingly, claims 6-8 are not obvious over Jones in view of Hirose.

Furthermore, there is no motivation or suggestion to combine the references in the references themselves, a requirement for a proper §103 rejection. Jones is directed to an automatic currency processing system for identifying the denomination of a scanned bill (U.S. Cl. 382/135), while Hirose is directed to an automatic bank note transaction apparatus for reducing the amount of stored bills by dispensing them in a subsequent withdrawal (U.S. Cl. 235/379). Teachings to address such divergent issues would not lead one of ordinarily skill in the art to combine Jones and Hirose.

As such, claims 4-6 and 8 would not have been obvious.

2. Claim 5 Is Not Obvious Over Jones In View Of Hirose And Guibard

Claim 5 was rejected under 35 USC §103(a) as being unpatentable over Jones in view of Hirose and in further view of Guibard. Office Action at 5. Specifically, the Office Action

alleges that, “it would have been obvious...to modify Jones’s banknote handling system with a left-money collection process that stores or collects a banknote, as taught by Guibard, for the purpose of recovering dispensed cash or notes automatically in certain conditions when abnormal or erroneous operation has been detected.” *Id.* However, claim 5 specifically recites that a banknote is stored or collected when it “is left in the money-in-out slot after the money out process....” Amendment at 3.

Furthermore, even if for the sake of argument, the cited references disclose every feature of the present claims, again there is no motivation or suggestion to combine Jones and Hirose in the references themselves, as previously mentioned above. Moreover, Guibord is directed to an automatic note dispenser with purge control (U.S. Cl. 221/21) for removing either dispensed notes that the user did not retrieve or notes left within the chamber.” Guibord at Abstract. As such, claim 5 is not obvious.

III. CONCLUSION

In conclusion, Applicant respectfully submits that claims 1-25 are now in condition for allowance, which is earnestly solicited.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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